

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO PALEARI and BUZZI GIAMPAOLO

Appeal No. 2004-1423
Application No. 09/807,210

ON BRIEF

Before WARREN, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 11 through 20, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a multi-layer heat-shrinkable film comprising an outer heat-sealing layer comprising at least one polyolefin, an outer abuse layer of a polyamide with a melting point of at least 175 °C, and an intermediate gas barrier layer comprising vinylidene chloride

copolymer (Brief, pages 7-8). Representative independent claim 11 is reproduced below:

11. A multi-layer heat shrinkable film comprising:

- a) an outer heat-sealing layer comprising at least one polyolefin;
- b) an outer abuse layer comprising a polyamide with a melting point of at least 175°C; and
- c) an intermediate gas barrier layer comprising vinylidene chloride copolymer;
wherein all the layers of the film are oriented.

The examiner has relied on the following references as evidence of unpatentability:

Arita et al. (Arita)	4,652,490	Mar. 24, 1987
Speer et al. (Speer)	5,350,622	Sep. 27, 1994

Claims 11-13 and 16-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Speer (Answer, page 3). Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Speer in view of Arita (Answer, page 4).¹ We reverse the rejection based on section 102(b) essentially for the reasons stated in the Brief and those reasons set forth below. Although we technically *affirm* the rejection based on section 103(a), we do so based on reasoning different than that proposed by the examiner, as explained below.

¹The examiner has withdrawn the rejection of claims 11-20 under the first paragraph of section 112 (Answer, page 5).

Accordingly, we denominate this affirmance as a *new ground* of rejection under the provisions of 37 CFR § 1.196(b). We also enter a *new ground* of rejection of claims 11-13 and 16-20 under 35 U.S.C. § 103(a) pursuant to our authority under 37 CFR § 1.196(b).

OPINION

A. *The Rejection under § 102(b)*

The examiner finds that Speer discloses a multi-layer heat-shrinkable film comprising an outer heat-sealing layer comprising a polyolefin, an outer abuse layer comprising a polyamide, and an intermediate gas barrier layer comprising polyvinylidene chloride (Answer, page 3, with citations to column and line of Speer). The examiner recognizes that Speer does not disclose or teach the claimed limitation that the polyamide has a melting point of at least 175 °C but the examiner asserts that this limitation is *inherent* to Speer since this reference discloses nylon 6/12 as the polyamide layer (*id.*).

Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [Citation omitted]." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in

the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' [Citation omitted]. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted]." *In re Robertson*, 169 F.3d at 745, 49 USPQ2d at 1950-51.

On this record, the examiner has failed to set forth any extrinsic evidence to establish that the polyamide described by Speer has a melting point within the claimed range. We assume that the examiner relies upon appellants' specification as evidence that nylon 6/12 has a melting point higher than 175 °C (Answer, page 6; see the specification, page 10, ll. 12-28). However, this reliance is misplaced since appellants' specification does not disclose that all nylon 6/12 polyamides have a melting point of greater than 175 °C. Furthermore, not all of the polyamides disclosed by Speer may have a melting point within the claimed range, thus requiring a selection from the group disclosed by the reference (e.g., the melting point of nylon 6/69 has not been established). As correctly argued by appellants (Brief, page 13), polyamides may

have various melting points, depending on many variables such as the exact composition and molecular weight.²

For the foregoing reasons and those stated in the Brief, we determine that the examiner has not established that every element of the claim is described by Speer within the meaning of section 102. Therefore we cannot sustain the examiner's rejection of claims 11-13 and 16-20 under 35 U.S.C. § 102(b) over Speer.

B. The New Ground of Rejection

Pursuant to our authority under 37 CFR § 1.196(b), we enter a new ground of rejection of claims 11-13 and 16-20 under 35 U.S.C. § 103(a) as unpatentable over Speer. We adopt the examiner's findings of fact as discussed above and in the Answer. Contrary to appellants' argument (Brief, page 13), numerous selections do not have to be made to arrive at the claimed invention. We note Examples 38-39 of Speer, where a multilayer shrink barrier structure is disclosed with an inner heat seal layer of polyolefin, an intermediate polyvinylidene chloride gas barrier layer, and an outer abuse layer of polyolefin, with all layers biaxially oriented (col. 22, ll. 25-40). Thus the only modification necessary to meet

²We note that appellants admit that "nylon 6 has a very high melting point, well above the 175 °C limit" (Brief, page 15), without specifying the composition or molecular weight of this nylon 6.

the limitations of claim 11 on appeal is the substitution of a polyamide with a melting point of greater than 175 °C for the polyolefin outer abuse layer of the Speer Examples 38-39. This modification would have been suggested to one of ordinary skill in this art by Speer, who teaches that the abuse layer (c) may be, *inter alia*, polyethylene or polyamide (col. 12, ll. 1-3), where the polyamide may be selected from various Nylons such as Nylon 6, 66, 6/12, 6/66, and 6/69 (col. 8, ll. 5-10). Accordingly, one of ordinary skill in this art would have been motivated to substitute a polyamide for the polyolefin of Examples 38-39 of Speer. See *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982) (Equivalence is its own motivation and no express suggestion is necessary to render such substitution obvious).

Regarding the claimed limitation of the melting point of the polyamide, we note that the polyamides described by Speer may have melting points slightly above or below 175 °C (see the discussion above and the Brief, page 13). However, merely claiming a melting point of a polyamide that may be slightly higher or lower than that disclosed by the prior art does not render the claimed subject matter patentable. The case law has "consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves

unexpected results relative to the prior art range. [Citation omitted]." *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Accordingly, in the absence of any such showing, we conclude that the use of polyamides with various melting points as the abuse layer would have been well within the ordinary skill in this art in view of the teachings of Speer.

With regard to claims 12-13 and 16-20, we adopt the examiner's findings of fact from Speer for each claim (Answer, page 3). Appellants argue that Speer refers only an "annular coextrudate" but fails to disclose or suggest that the multi-layer heat-shrinkable film is in the form of a seamless tubing as required by claim 19 on appeal (Brief, page 14). This argument is not persuasive since, as correctly noted by the examiner (Answer, pages 3 and 6), Speer discloses that the film is in the form of a tubing while teaching a method of preparation where no seams are produced (see col. 12, ll. 4-21).

For the foregoing reasons, we determine that the claimed subject matter would have been *prima facie* obvious to one of ordinary skill in this art at the time of appellants' invention in view of the reference evidence. Therefore we enter the new ground of rejection of claims 11-13 and 16-20 under section 103(a) over Speer.

We adopt the findings of fact and conclusion of law as stated by the examiner with regard to the rejection of claims 14-15 under section 103(a) over Speer in view of Arita (Answer, pages 4-5). However, since we have applied Speer on a different basis than proposed by the examiner, we denominate the "affirmance" of the rejection on appeal as a new ground of rejection pursuant to the provisions of 37 CFR § 1.196(b).

Appellants argue that the film structure of Arita differs from that claimed, and there is no motivation articulated by the examiner for the combination of references (Brief, pages 15-16). These arguments are not well taken. The examiner has not applied Arita to show the identical film structure to that claimed by appellants. The examiner has clearly set forth the teachings of Arita and the motivation for the combination of references (Answer, pages 4-5 and 7-8).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence.

C. Summary

The rejection of claims 11-13 and 16-20 under 35 U.S.C. § 102(b) over Speer is reversed.

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A new ground of rejection of claims 11-13 and 16-20 under 35 U.S.C. § 103(a) over Speer has been entered. The rejection of claims 14-15 under 35 U.S.C. § 103(a) over Speer in view of Arita has been "affirmed" but denominated as a new ground of rejection.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:


(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED/37 CFR § 1.196(B)


CHARLES F. WARREN
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

BOARD OF PATENT
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